

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

APPLICANT(S): Jeong-Kyu MOON

GROUP ART UNIT: 2617

APPLICATION NO.: 10/646,153

EXAMINER: Pierre Louis DESIR

FILING DATE: August 21, 2003

DATED: November 15, 2007

**FOR: METHOD FOR PERFORMING A ONE-TOUCH CALL
OPERATION USING A WIRELESS MOBILE TERMINAL**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

REAL PARTY IN INTEREST

The real party in interest is Samsung Electronics Co., Ltd., the assignee of the subject application, having an office at 416, Maetan-dong, Yeongtong-gu, Suwon-si, Gyeonggi-do, Republic of Korea.

RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge and belief, there are no currently pending related appeals, interferences or judicial proceedings.

STATUS OF CLAIMS

The original application filed on August 21, 2003 contained Claims 1-10. In a Response filed September 1, 2005, Claim 1 was amended. In a Response filed February 21, 2006, Claims 1-3 were cancelled. In a Response filed April 21, 2006, Claims 4 and 8 were amended. In a Response filed February 22, 2007, Claims 4 and 8 were amended.

Thus, Claims 4-10 are pending in the Appeal. Claims 4 and 8 are in independent form.

For the purposes of this appeal, Claims 4-10 stand or fall together.

STATUS OF AMENDMENTS

To date, all of the amendments to the claims have been entered. Thus, the Appendix to this Appeal Brief includes Claims 4-10, of which the status of Claims 4 and 8 are indicated as “Previously Presented,” the status of Claims 5-7, 9 and 10 are indicated as “Original,” and the status of Claims 1-3 are indicated as “Cancelled.”

SUMMARY OF CLAIMED SUBJECT MATTER

The invention as recited in Claim 4 relates to a method for performing a one-touch call operation using a mobile terminal. The method includes attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal. (Specification at page 4, lines 22-24, and FIG. 2, S50).¹ The method further includes, if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal. (Specification at page 4, line 24, through page 5, line 13, and FIG. 2, S52-58).

The invention as recited in Claim 8 relates to a method for performing a one-touch call operation using a mobile terminal. The method includes attempting to establish a call connection

¹ Although a citation for each feature of the claims is provided herein, Appellant notes that support may be found elsewhere in the written description.

with a counterpart mobile terminal using the mobile terminal. (Specification at page 4, lines 22-24, and FIG. 2, S50). The method further includes, if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal. (Specification at page 7, lines 10-11, and FIG. 4, S80). The method yet further includes transmitting, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal and a predetermined message, corresponding to the one-touch call button to the counterpart mobile terminal. (Specification at page 7, lines 13-15, and FIG. 4, S84).

GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 4-10 are unpatentable under 35 U.S.C. §103(a) over Applicant's Admitted Prior Art (hereinafter, *AAPA*) in view of U.S. Publication No. 2004/0092294 to *Moran*.

ARGUMENT

The Examiner rejected Claims 4-10 under 35 U.S.C. §103(a) as being unpatentable over *AAPA* in view of *Moran*.

I. Claims 4-10 are patentable over the combination of *AAPA* and *Moran*

A. Claim 4

Claim 4 recites a method for performing a one-touch call operation using a mobile terminal. The method includes attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal. The method further includes, if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal.

AAPA essentially discloses that when a call is not established, the calling mobile terminal may gain access to a message inbox, which requires many substeps to leave a message for the called

mobile terminal. Further, the conventional method of transmitting text messages to a called mobile terminal after the calling mobile terminal fails to establish a call connection with the called mobile terminal, typically requires the user of the calling mobile terminal to manually press a plurality of keys corresponding to a phone number of the called mobile terminal.² In *Moran*, a messaging system is disclosed whereby a system is arranged to allow a user to send a pre-specified message to a destination party mailbox through a telephone handset.³

Regarding Claim 4, in the final Office Action the Examiner maintained the allegation that the combination of *AAPA* and *Moran* teaches each and every element of Claim 4.⁴ To support this contention, the Examiner correctly conceded that *AAPA* does not teach the recitation of “pressing a one-touch call button of the mobile terminal that transmits using information entered during the attempt to establish connection, a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal,” as recited in Claim 4.⁵ Nevertheless, the Examiner uses *Moran* to cure this deficiency. However, after reviewing *AAPA* in light of *Moran*, Appellant respectfully disagrees, and asserts that the combination of *AAPA* and *Moran* fails to teach or suggest the elements of Claim 4 because *Moran* fails to remedy the above deficiency of *AAPA*.

Nothing in *Moran*, as a whole or in part, fairly teaches or even suggests the “pressing” step of Claim 4 reiterated above. *Moran* teaches connecting to a messaging server, and then, when pressing a specific key during such a connection, beginning a transmission process. More specifically, *Moran* discloses that a user first presses a feature key on the telephone, which indicates that the user requires to send one of the messages. A time compression multiplexed (TCM) control signal is sent from the telephone to the PBX CPU core. A display message is then sent back from the PBX CPU core to the telephone requesting the user to enter the telephone number of the voicemail box at which a message is to be left.⁶

While *Moran* discloses a feature key, it also requires the user to enter additional information relating to the destination of the message. Thus, *Moran* fails to disclose a “one-touch button” that transmits a predetermined message, as recited in independent Claim 4.

² See Specification at pages 1-2.

³ See *Moran* at abstract.

⁴ See Office Action dated May 16, 2007, at page 2.

⁵ See Office Action dated May 16, 2007, at page 3.

The depression of the feature key in *Moran* indicates that a user requires to send a pre-recorded message, however, *Moran* fails to disclose that the feature key actually transmits the message, as recited in independent Claim 4. Instead, *Moran* discloses that a copy of a pre-recorded message is recorded at a destination mailbox after a directory number is entered.⁷

The transmission of a message through the use of a one-touch button in the present invention is enabled through the use of information that was previously entered during a failed attempt to establish a call connection. *Moran* fails to disclose that the message transmission utilizes any information that was previously entered. *Moran* also fails to disclose that the message transmission utilizes information from a previous attempt to establish a connection. Thus, *Moran* fails to teach or suggest that a one-touch button enables the transmission of a predetermined message using information entered during an attempt to establish a call connection that had failed, as presently recited in Claim 4 of the application.

In the latest Advisory Action, in attempting to provide support for the argument that *Moran* remedies the deficiency of *AAPA*, the Examiner contends that a user is able to send one of the pre-recorded messages to the mailbox of a destination party by providing information about the directory number of the destination party mail box and, for example, pressing a particular function key on a telephone handset.⁸ However, the Examiner has further illustrated Appellant's assertions described above, in that *Moran* fails to disclose a one-touch button that transmits a message, and instead requires additional information to be entered for transmission of the message. Further, the Examiner does not address that *Moran* fails to disclose that transmission is enabled through the use of information that was previously entered during a failed attempt to establish a call connection.

Accordingly, *Moran* fails to remedy the deficiency of *AAPA* described above and thus, the combination of *AAPA* and *Moran* fails teach or suggest each and every element of Claim 4. Further, the elements of Claim 4 are not obvious in view of the combination of *AAPA* and *Moran*. Therefore, it is respectfully submitted that Claim 4 is believed to be allowable over the combination of *AAPA* and *Moran*.

⁶ See *Moran* at page 3, paragraph 43.

⁷ See *Moran* at page 3, paragraph 43.

B. Claim 8

Claim 8 recites a method for performing a one-touch call operation using a mobile terminal. The method includes attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal. The method further includes, if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal. The method yet further includes transmitting, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal and a predetermined message, corresponding to the one-touch call button to the counterpart mobile terminal.

Appellant asserts that Claim 8 is patentable for at least the reasons presented above with regard to Claim 4. More specifically, Claim 8 recites the step of pressing a one-touch call button of the mobile terminal, and transmitting a phone number and a message using information entered during the attempt to establish a call connection. As described above with regard to Claim 4, *Moran* fails to teach or suggest a one-touch button that transmits a message. *Moran* also fails to teach or suggest that transmission of a message is enabled through the use of information that was previously entered during a failed attempt to establish a call connection. Accordingly, *Moran* fails to remedy the deficiency of *AAPA* described above and thus, the combination of *AAPA* and *Moran* fails to teach or suggest each and every element of Claim 8. Further, the elements of Claim 8 are not obvious in view of the combination of *AAPA* and *Moran*. Therefore, it is respectfully submitted that Claim 8 is believed to be allowable over the combination of *AAPA* and *Moran*.

C. Claims 5-7, 9 and 10

Regarding the rejection of Claims 5-7, 9 and 10, the Examiner maintained their rejections under 35 U.S.C. §103(a). Claims 5-7, 9 and 10 are patentable at least by virtue of their dependency from independent Claims 4 and 8. The patentability of Claims 4 and 8 is described above. Claims 5-7, 9 and 10 also recite patentable subject matter in their own right. Accordingly, it is respectfully submitted that because the above arguments place the independent claims in condition for allowance, that these dependent claims are also believed to be in condition for allowance.

⁸ See Advisory Action dated August 27, 2007 at page 2.

CONCLUSION

As the Examiner has failed to make out a *prima facie* case for an obviousness rejection, the rejection of Claims 4-10 must be reversed.

It is well settled that in order for a rejection under 35 U.S.C. §103(a) to be appropriate, the claimed invention must be shown to be obvious in view of the prior art as a whole. A claim may be found to be obvious if it is first shown that all of the recitations of a claim are taught in the prior art or are suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974), cited in M.P.E.P. §2143.03.

The Examiner has failed to show that all of the recitations of Claims 4-10 are taught or suggested by the art of record, or the combination thereof. Accordingly, the Examiner has failed to make out a *prima facie* case for an obviousness rejection.

Independent Claims 4 and 8 are not rendered unpatentable by either *AAPA* or *Moran*, or any combination thereof. Therefore, the rejection of Claims 4-10 must be reversed.

Dated: November 15, 2007

By: 

Paul J. Farrell

Reg. No.: 33,494

Attorney for Applicant(s)/Appellant(s)

THE FARRELL LAW FIRM, P.C.
333 Earle Ovington Blvd., Suite 701
Uniondale, New York 11553
(516) 228-3565 (tel)
(516) 228-8475 (fax)

CLAIMS APPENDIX

1-3. (Cancelled)

4. (Previously Presented) A method for performing a one-touch call operation using a mobile terminal, comprising the steps of:

attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal; and

if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal that transmits, using information entered during the attempt to establish the call connection, a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal.

5. (Original) The method as set forth in claim 4, wherein the step pressing the one-touch call button of the mobile terminal, includes the steps of:

reading out a phone number of the mobile terminal and the predetermined message from a memory of the mobile terminal; and

simultaneously transmitting the phone number of the mobile terminal and the predetermined message to the counterpart mobile terminal.

6. (Original) The method of Claim 4, wherein the predetermined message is a previously recorded voice message.

7. (Original) The method of Claim 4, wherein the predetermined message is a previously entered text message.

8. (Previously Presented) A method for performing a one-touch call operation using a mobile terminal, comprising the steps of:

attempting to establish a call connection with a counterpart mobile terminal using the mobile terminal;

if the call connection between the mobile terminal and the counterpart mobile terminal fails, pressing a one-touch call button of the mobile terminal; and

transmitting, using information entered during the attempt to establish the call connection, a phone number of the mobile terminal and a predetermined message corresponding to the one-touch call button to the counterpart mobile terminal.

9. (Original) The method of Claim 8, wherein the predetermined message is a previously recorded voice message.

10. (Original) The method of Claim 8, wherein the predetermined message is a previously entered text message.

EVIDENCE APPENDIX

There is no evidence submitted pursuant to 37 C.F.R. 1.130, 1.131, 1.132 or entered by the Examiner and relied upon by Appellant.

RELATED PROCEEDINGS APPENDIX

There are no known decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. 41.37.